

29. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation independent of a user input.

30. The computer system of claim 27, wherein the override module changes the first color designation for printing of the subset to the second color designation based on a user identification.

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on January 29, 2001, and the references cited therewith.

No claims have been added, canceled or amended; as a result, claims 1-30 remain pending in this application.

### **§112 Rejection of the Claims**

Claims 1 and 12 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant respectfully traverses the rejection. The Office Action asserts two reasons why the claims are vague, indefinite or incomplete. First, the Office Action states “[i]f the color designation is overridden (i.e. canceled) how can the next step of printing occur, absent a step of substitution of a different color designation.” Applicant respectfully submits that the Office Action, in limiting the term overridden to mean cancel, is interpreting the term “overridden” too narrowly. While cancellation is within the scope of the term, substitution or modification is also within the meaning of the term. For example, the American Heritage College Dictionary (third edition 1997) at page 975 defines the term override to include “to counteract the normal operation of (an automatic control).” In other words, an action is substituted for the action being overridden. Thus, the term overridden includes the action (substitution) that the Office Action asserts is absent.

Second, the Office Action asserts that the claims are vague as to whether or not the subset is printed as part of the printable information units when printing occurs. Claims 1 and 12 specifically recite that the subset is a “subset of a plurality of printable information units” and

further recites “printing the plurality of printable information units.” The plain meaning of the recited language of claims 1 and 12 is that the subset is printed, because the subset is by definition a part of the plurality of printable information units.

For the above reasons, claims 1 and 12 are not vague, indefinite, or incomplete. The Examiner is therefore respectfully requested to withdraw the rejection of claims 1 and 12.

### **§103 Rejection of the Claims**

Claims 1-30 were rejected under 35 USC § 103(a) as being unpatentable over Rivette et al. (U.S. Patent No. 5,809,318) in view of Narendranath et al. (U.S. Patent No. 5,751,434). Applicant respectfully traverses the rejection, because the Office Action does not present a *prima facie* case of obviousness with respect to the claims.

In order to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully submits that the cited references do not teach or disclose each and every element of Applicant’s claims, and that no motivation to combine the references has been stated.

For example, Applicant’s independent claims 1 and 12 each recite “overriding a color designation for printing of a subset of a plurality of printable information units.” The Office Action implies that Rivette teaches the recited language because the “Equivalent File” taught by Rivette can be “highlighted by user choice in a color different than the usual default color (black).” Applicant respectfully submits that the Office Action misapplies Rivette. The activity of highlighting an element in the Equivalent File is in fact designating a color. There is no teaching or disclosure that this color designation, once made, is overridden when the Equivalent

File is printed. In other words, the color designation is the same both when viewed on a monitor, and when the Equivalent File is printed. Thus there is no overriding of the color designation when the document is printed. Furthermore, Applicant has carefully reviewed Rivette, including performing a computerized text search, and can find no reference to the term overriding, or variants of the term. Therefore, Rivette does not teach or disclose the recited language.

Furthermore, Applicant has carefully review Narendranath, including performing a computerized text search for the term overridden, and can find no teaching or disclosure of the recited language. As a result, neither cited reference discloses the each and every element of Applicant's claims, and a *prima facie* case of obviousness does not exist. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1 and 12.

In addition, the Office Action has not stated a motivation to combine Rivette and Narendranath. The Office Action states that the reference to Narendranath "is merely cited to show a printer capable of single or multicolor printing." No motivation to combine the references has been supplied. As a result, the Office Action fails to present a *prima facie* case of obviousness. Applicant further notes that the claims do not recite or inherently require a particular type of printer.

With respect to claim 2, the Office Action asserts that the claim is directed to "changing from a non-black color for highlighting a subset." Applicant respectfully disagrees with this interpretation of claim 2. Claims 2 and 13 each recite "overriding the color designation for printing ... includes changing for printing a non-black color designation of the subset to a black color designation." Thus, the changing of color is not for highlighting a subset as is performed in Rivette, rather it is overriding the designated color (i.e. the highlighting) to another color when the document is printed.

Claims 3 and 14 recite "overriding the color designation for printing of the subset of the plurality of printable information units is independent of a user input.", The Office Action asserts that Rivette, at column 3, lines 46-50 suggests the recited language because no human intervention is required to obtain a usable equivalent file. The cited section of Rivet in fact discusses that pagination of the Equivalent File can be achieved without human intervention. Neither the cited section nor Rivette in general state anything related to color designation

independently of user input, nor does it state anything related to overriding a color designation independently of user input. Furthermore, Narendranath does not teach or disclose overriding a color designation. Thus, the cited art, either alone or in combination does not teach the recited language and the rejection of claim 3 is improper.

Generic claim 1, as discussed above, is believed to be allowable. Further, claims 4-11 and 15-30 are allowable for the reasons discussed above regarding claim 1. Applicant respectfully requests withdrawal of the rejection of claims 4-11 and 15-30.

### Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612-373-6954) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 50-0439.

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on this 30<sup>th</sup> day of April, 2001.

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